

Application No.: 10/698,100
Amendment Dated: November 22, 2005

REMARKS

Reconsideration of the merits of the application is respectfully requested in light of the remarks that follow. Claims 1, 3, 4, 6, 7, 11, 13, and 15-29 remain pending after entry of this amendment. Claims 1, 6, 7, 13, and 29 were amended herein, and claims 2, 5, 8-10, 12, 14, and 30 were cancelled herein.

Support for the amendment to claim 1 can be found at least at paragraphs 87 and 89. Paragraph 89 discloses providing dosages of botulinum toxin between approximately 1.25 and 10 units per 0.1 milliliter, while paragraph 87 provides that overall dosages of less than 4 milliliters may be delivered. This can therefore be calculated to a dosage of between approximately 50 and 400 units.

Rejections over Desai in view of Edwards and Schmidt

Claims 1, 3-7, 11-14, 16-23 and 25-30 are rejected under 35 USC §103 as allegedly being unpatentable over U.S. Patent No. 6,231,591 (Desai) in view of U.S. Patent No. 5,599,294 (Edwards). Claims 2, 8-10, 15, and 24 are rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Desai in view of Edwards in further view of U.S. Patent No. 6,365,164 (Schmidt). Applicant respectfully traverses these rejections.

With respect to claims 1, 3, 4, 6, 7, and 11, Applicant has amended claim 1 to specify that “the total dosage of botulinum toxin delivered to the prostate is from approximately 50 units to approximately 400 units”. Applicant respectfully asserts that neither Desai nor Edwards renders claim 1 obvious in light of this element.

As the Examiner admits, Desai does not offer any description or suggestion of particular denervating agents, and certainly no guidance regarding the dosage amounts. Furthermore, Schmidt, which the Examiner refers to as rendering claims 2, 8-10, 15, and 24 obvious does not disclose or suggest this dosage amount. Schmidt discloses a number of dosage amounts and dosage methods. Specifically, when talking about injection into the affected area, Schmidt discloses that the preferred amount is up to about 2500 units (column 5, lines 53-60). Based on this disclosure of Schmidt, amended claims 1, 3-7, and 11 are not obvious.

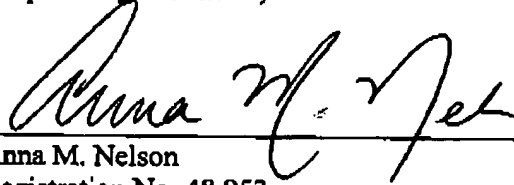
With respect to claims 13, and 15-29, Applicant has amended claims 13 to recite that the “needle is spring-loaded such that when the actuator causes the needle to extend through the

Application No.: 10/698,100
Amendment Dated: November 22, 2005

hole, the needle is spring biased into the prostate gland” and claim 29 to add a “means for spring biasing the needle into the prostate gland”. With respect to former claims 14 and 30 the Examiner cited column 19, lines 31-32 of Desai. Applicant respectfully disagrees that this portion of Desai discloses a spring biased needle. The particular line that the Examiner is referring to (column 19, lines 31-32), if read in the context of the paragraph clearly refers to a method of making electrical contact, and has nothing to do with the action of the needle into the prostate. Further context is also provided by the preceding paragraph (column 19, lines 12-22). Because Desai does not disclose or suggest a spring biased needle, claims 13, and 15-29 are not obvious over Desai in light of Edwards.

In view of the foregoing amendments and remarks, it is believed that the application is now in condition for allowance and notice of this, in the form of a notice of allowance is respectfully requested.

Respectfully submitted,



Date: November 22, 2005

Anna M. Nelson
Registration No. 48,953
MEDTRONIC, INC.
710 Medtronic Parkway NE, M.S.: LC340
Minneapolis, Minnesota 55432-5604
Telephone: (763) 505-0405
Facsimile: (763) 505-0411
CUSTOMER NO.: 27581